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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,926	01/18/2001	Alan John Lunn	12805-002001	9930

7590                    11/27/2002

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NGUYEN, ANTHONY H

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2854

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/764,926	LUNN, ALAN JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anthony H Nguyen	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 September 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 14-28, 39 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how the window is selectively detachable from the housing (claim 4, line 2). Claim 14, lines 15 and 16, the language “substantially coincident” and “substantially all movements” is indefinite since it fails to point out and distinctly claim any structure since this claim language based on the present specification fails to enable a person in the art to reliably determine what would or would not infringe this claim. Also, note that the center gravity of the device as claimed is not defined. Additionally, there is no proper antecedent basis for “the screw” (claim 20, line 4), “said clevis” (claim 39 line 4) and “said lead” (claim 52 line 2).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,7, 14,15,23,24, 30,31,41, 49-51 and 56 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Troester (US 6,135,022).

Troester teaches a marking device which meets the structure as broadly claimed.

Troester teaches a marking device 10 having a housing 50 (Fig.3), a frame pivotally mounted in

the housing about an axis 30, a marking head 14 which includes a pin 12 which is actuated by a solenoid (not shown, Troester, col.10 line 13) and moved parallel to the pivoted axis by a motor 28, and a motor 22 which is used to pivot the frame in a substantially orthogonal direction.

With respect to claims 2, 31 and 49-51, Troester teaches the use of a console or a controller 70, a handle 82 having a trigger 84 for operating the device as shown in Figs. 4A and 4B. With respect to claims 1, 3 and 24, Fig.3 of Troester shows the housing 50 which encases the device and having a window (no reference) through which the marking head 14 protrudes between the standoffs 48.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, and 40 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Robertson et al. (US 4,808,018).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the window which is detachable from the housing of the marking device. However, Robertson et al. teaches a marking device having a forward plate or a window 18 which is detachable from the housing 15 via the screws and frames 74,76 as shown in Figs.4 and 7 of Robertson et al. Therefore, in view of the teaching of Robertson et al., it would have been obvious to one of ordinary skill in the art to modify the marking device of Troester by providing the window as taught by Robertson et al. to permit more precise control the position of marking device over a surface to be marked. With

respect to claims 5 and 6, the selection of a desired material and a V-section shaped window would be obvious through routine experimentation in order to get best possible distance over the object to be marked.

Claims 8-11,20-22, 25-27,37, 42-44,46-48 and 52 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Curreno (US 6,188,148).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach a carriage which is slidably moved on a rail for moving the marking head. However, Curreno teaches a marking device 10 having a carriage 16 or 116 which moves the marking head 12 to a desired position via rails 138 as shown in Figs.3 and 8 of Curreno. In view of the teaching of Curreno, it would have been obvious to one of ordinary skill in the art to modify the marking device of Troester by substituting the carriage which moves on the rails as taught by Curreno for reducing cost of manufacture of a marking device in place of the carriage 15 of Troester. With respect to claims 20-22 and 37, the use of a clevis or a bracket which supports a screw of a motor is well known in the art. For example, see the clevis or bracket 440 which supports a finger or a rod 428 as shown in Fig.14 of Curreno, and the motor mount or the clevis 38 which supports the motor 18 in Troester (Fig.2). With respect to claims 46-48, the selection of a desired distance between a marking point of the marking head and the motor involves only an obvious matter of design choice and no unobviousness is apparent in selecting the desired distance which depends on the sizes of components containing in the housing of the device.

Claims 12,13,16-19,28,29, 33-36,38,39 , 45 and 53-55 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Troester (US 6,135,022) in view of Wadge (US 6,263,980).

Troester teaches a marking device having substantially the structure as recited in the claims. See the explanation of Troester above. Troester fails to teach the housing which is a

clamshell housing. However, Wadge teaches a power tool 2 having a clamshell housing 4 that includes ribs 30 which function as a bearing bush to secure a motor 22 in place. In view of the teaching of Wadge, it would have been obvious to one of ordinary skill in the art to modify the housing of the marking device of Troester by substituting the clamshell housing as taught by Wadge for simplicity of producing a housing of a marking device. With respect to claims 16 and 33, the use of a motor having a rotary armature threaded on a fixed screw is well known in the art. For example, see Wadge, col.6 lines 22-29. With respect to claims 38,39,54 and 55, see the discussion of claims 20-22 and 37 above.

*Response to Arguments*

Applicants' arguments filed on September 24, 2002 have been fully considered but they are not persuasive of any error in the above rejections. Applicant argues that Troester, Robertson et al., Curreno, and Wadge fail to teach or suggest the marking device as recited. Specifically, applicant argues that Troester does not teach the housing which forms an integral component of operation.

However, as explained above, Troester teaches a housing which encases the marking device including marking head, a frame and a base, a carriage and motors for driving the marking head. The housing is inherently integrated with the marking device so that the device can be operative.

Applicant argues that Troester does not teach a carriage mounted on a frame for translation movement, and that the marking head of Troester does not operate in a plane coincident with the center of gravity of the components such as the frame, the carriage, and motors as recited in claims 14 and 30.

Note that Figs. 1 and 2 of Troester clearly shows the carriage 15 mounted on a frame 28 via guide rod 24 and 26 for translational movement that meets the structure as recited in the claim. Note also the device of Troester has a center of gravity for all the components including the marking head, the frame and the motors since the components are secured to the frame as an integral component for operation. The marking head of Troester is operated coincident with the plane defined by the movement of the carriage and the frame since the marking head is secured to the frame via the guide rods 24 and 26 in line with the frame as recited in the claims 14 and 30.

Applicant merely states that Robertson et al., Curreno, and Wadge do not teach the feature lacking in Troeste, but does not explain or discuss the reasons why applicant considers the rejections improper. As explained above, note that Robertson et al. clearly teaches the forward plate which is detachable, Curreno teaches the mechanism including a rail and marking head fixed to a slidably carriage, and Wadge teaches the housing which is a clamshell housing. Therefore, it is believed that the rejections are proper since there is no apparent unobviousness in the structure claimed relative to the structure of the prior art as applied to claims 4,6,8-13,16-22,25-29,30,31,33-40,42-48 and 52-56.

### *Conclusion*

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY

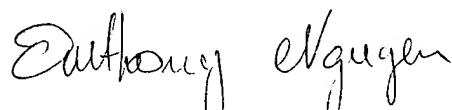
Art Unit: 2854

ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (703) 308-2869. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (703) 305-6619. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



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11/25/02  
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